

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

Rejection of claims 1-18 under 35 U.S.C. § 112, second paragraph

Claims 1-18 presently stand rejected as being indefinite. Applicant has cancelled claims 1-18, and added new claims 19-25, rendering this rejection moot. Applicant respectfully submits that claims 19-25 particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of claims 1-18 under 35 U.S.C. § 102(b) and 102(e)

Applicant respectfully submits that the citation of *sixty-five references*, each said to anticipate all of claims 1-18 of the present application, with only the statement that “the following references teach the structures and concepts taught in Figures 1-6 of the present invention” does not *clearly articulate* a basis for rejection of claims 1-18 of the present application. Referring to the MPEP, “the goal of examination is to *clearly articulate any rejection* early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” (MPEP 706) (emphasis added).

In rejecting claims, the examiner is called upon to cite “the best references at his or her command.” (37 CFR 1.104 (c)(2)). “The pertinence of each reference, if not apparent, must be *clearly explained* and *each rejected claim* specified.” (*id*) (emphasis added). It is respectfully submitted that the mere citation of *sixty-five references*, with *no comment or explanation* regarding how any of these references applies, falls short of this standard.

“In selecting the references to be cited, the examiner should carefully *compare the references with one another and with the applicant's disclosure to avoid the citation of an unnecessary number*. The examiner is not called upon to cite all references that may

be available, but only the 'best.'" (37 CFR 1.104(c)) "Multiplying references, any one of which is as good as, but no better than, the others, *adds to the burden and cost of prosecution and should therefore be avoided.*" (MPEP 904.03) (emphasis added).

Applicant notes that "a claim is anticipated only if *each and every element* as set forth in the claim *is found*, either expressly or inherently described, in *a single prior art reference.*" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, (Fed. Cir. 1987) (emphasis added). Assuming, *arguendo*, that any of the sixty-five cited references truly teaches each and every element as set forth in claims 1-18, it would appear that the citation of *sixty-five references*, with no further explanation of the applicability of any of the references to any of the claims individually, is an example of the burdensome and costly practice of multiplying references which is explicitly discouraged by the MPEP.

While the examiner contends that each of the sixty-five references each anticipates each of claims 1-18, and states that "if Applicant looks at any of the patent used (listed) in the 102(b) and 102(e) references, he will see every teaching that he has supposedly disclosed," Applicant needs to look no further than the *first cited reference* (EP591933) to dispute this assertion.

Referring to claim 7 of the present application, for example, it is recited that a backrest extends to form hind legs of the chair. This feature is entirely lacking from EP591933, wherein each embodiment illustrated includes a backrest that is separate from any leg members, and in particular is not extended to form hind legs of the chair. Claim 9 of the present application recites that a reclining means is incorporated between top and bottom portions of the backrest, and that the reclining means comprises a metal plate spring. EP591933 offers no teaching or suggestion of a metal plate spring. Therefore, EP591933 cannot be applied to anticipate claims 1-18, because at least claims 7 and 9 include limitations not found in EP591933.

Referring to the first cited U.S. patent reference (U.S. 4,084,850), similar shortcomings are found. U.S. 4,084,850 does not teach or suggest a backrest that has top

and bottom portions with a reclining means incorporated between the top and bottom portions. U.S. 4,084,850 does not disclose or suggest a metal spring plate, and U.S. 4,084,850 does not disclose or suggest that a backrest extends to form hind legs of the chair. Therefore, U.S. 4,084,850 cannot be said to anticipate claims 1-18 because elements are recited that are not found in U.S. 4,084,850.

Even looking at the oldest patent cited (since the examiner contends that “every concept and/or embodiment disclosed has been patented already and has been around as far back as the year 1856”), U.S. 14,364 (issued in 1856) does not disclose a backrest that extends to form hind legs of the chair, and U.S. 14,364 does not disclose a metal plate spring or any other spring member disposed between upper and lower parts of a backrest. Therefore, the examiner’s bold assertion that “every concept and/or embodiment disclosed has been patented already and has been around as far back as the year 1856” is simply not supported by the cited references.

Thus, it can be seen that, although the rejection states that claims 1-18 are rejected as being anticipated by each of the sixty-five cited references, this cannot be the case since it can be clearly seen that the sixty-five references include patents that do not teach or suggest each and every limitation of *each of the claims pending*.

However, with no further explanation by the examiner as to how each reference applies to each claim, or even to a subset of the claims, Applicant is not afforded an opportunity to provide evidence of patentability and otherwise reply completely to the rejection.

In view of the lack of specificity of the present rejection, Applicant has cancelled claims 1-18, and added new claims 19-25, rendering the present rejection moot. It is respectfully submitted that claims 19-25 recite material which is novel and non-obvious, and it is therefore respectfully submitted that claim 19-25 are fully patentable.

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Art Unit: 3636

Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 19-25 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "John R. Schaefer", written in a cursive style.

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